

Remarks

No claims were amended or cancelled. Claims 26 and 27 are new. Claims 1 to 27 are pending.

Applicants respectfully submit that no new matter is added with claims 26 and 27, which are fully supported by the specification as filed. For example, support for new claims 26 and 27 can be found at, but not limited to, page 5, lines 7-10 and lines 26-32; page 6, lines 3-5; and page 11, lines 16-18.

Applicants respectfully respond to the present office action as follows.

§ 103 Rejections

Claims 1, 2, 9, 12, 13, 23 and 24 were rejected under 35 USC § 103(a) as being unpatentable over Stephens (U.S. Pat. No. 5,380,046) in view of Smith (U.S. Pat. No. 5,410,827).

Claims 3 and 5 were rejected under 35 USC § 103(a) as being unpatentable over Stephens as modified by Smith and further in view of Killey.

Claims 4, 6-8, 10, 11, 14-16 and 19-21 were rejected under 35 USC § 103(a) as being unpatentable over Stephens as modified by Smith and further in view of McConville et al.

Applicants respectfully traverse the rejections as follows.

Claims 1, 2

The Examiner has essentially repeated the rejection of claims 1 and 2 as presented in the Office Action dated February 24, 2005. In response, Applicants respectfully repeat their May 24, 2005 discussion as to why Stephens and Smith do not support a proper prima facie case of obviousness. Applicant addresses the Examiner's response to these arguments below.

As previously presented, the cited documents do not teach or suggest all of the elements recited in claims 1, 2. For example, the cited documents do not teach or suggest a transparent data sheet having a transparent durable layer and a transparent fragile layer, as recited in claim 1. In contrast, Stephens provides a "plastic envelope 12" that "comprises dual rectangular plies 12', 12" of a transparent thermoplastic material . . ." (Col. 3, lines 7-12). Stephens does not teach or suggest that these materials are structurally different. Rather Stephens provides that the plies 12'

and 12" are made of the identical transparent thermoplastic material. So, it is not possible for Stephens' to teach or suggest that the plies 12' and 12" are some how both "durable" and "fragile" as asserted by the Examiner.

In addition, the cited documents do not teach or suggest a transparent data sheet that includes, besides other things, a transparent fragile layer and a second transparent fragile layer, where the two layers are laminated together to form a laminate, wherein the laminate is durable, as recited in claim 2.

As the Examiner appreciates, during examination, the claims must be interpreted as broadly as their terms reasonably allow. This means that the words of the claim must be given their plain meaning unless applicant has provided a clear definition in the specification. In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989). It is only when the specification provides definitions for terms appearing in the claims that the specification can be used in interpreting claim language. In re Vogel, 422 F.2d 438, 441, 164 USPQ 619, 622 (CCPA 1970). Where an explicit definition is provided by the applicant for a term, that definition will control interpretation of the term as it is used in the claim. Toro Co. v. White Consolidated Industries Inc., 199 F.3d 1295, 1301, 53 USPQ2d 1065, 1069 (Fed. Cir. 1999).

Applicants clearly recite the features upon which they rely in the claims. In addition, Applicants clearly define and distinguish the recited terms "durable" and "fragile" in the specification, where "[t]he term 'fragile' as used in this application means a film or material that is mechanically weak and is typically constructed with a removable carrier layer for ease of handling or stability for printing" (page 2, lines 24-26), and "[a]s used in the application 'durable' means a film that is free-standing film, without the necessity of a carrier layer and is thermally stable to withstand laminating or other processing temperatures, typically in the range of 100 to 150°C, as well as repeated handling" (page 2, lines 26-29). These definitions provided by the Applicants are even consistent with secondary source definitions of "fragile" (1. Easily broken, damaged, or destroyed; frail. 2. Lacking physical . . . strength; delicate. 3. Lacking substance; tenuous or flimsy" The American Heritage Dictionary of the English Language, Third Edition, 1992, p. 720) and "durable" (1. Capable of withstanding wear and tear or decay . . . 2. Lasting; stable" The American Heritage Dictionary of the English Language, Third Edition, 1992, p. 572).

In responding to the Applicants' argument, the Examiner asserts that "it is noted that the features upon which applicant relies (i.e., the specific [sic] of the 'durable' and 'fragile' layers) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181 26 USPQ2d 1057 (Fed Cir. 1993)."

As discussed above, Applicant expressly recites the terms "fragile" and "durable" in the claims, where these terms are clearly and expressly defined in the specification. This is in contrast to the facts in *In re Van Geuns*, cited by the Examiner, in which Van Geuns tried to limit the phrase "uniform magnetic field" of a magnetic assembly recited in the claim to that of an NMR or MRI apparatus among others generally provided in the specification. In other words, Van Geuns tried to limit the phrase recited in the claim by narrowly reading its meaning from a broader recitation in the specification. As such, *In re Van Geuns* is distinguished from the present case, as Applicants' has provided an explicit definition for the terms "fragile" and "durable" that defines and controls the interpretation of the term as used in the claim.

In addition, Applicants respectfully submit that even if the Examiner maintains the assertion that the express definitions provided in the specification for "fragile layer" and "durable layer" cannot be read into the claim language, the plain meaning of the words "fragile" and "durable" (see above dictionary definitions for these words) for the layers recited in claim 1 distinguishes the claim over Stephens. This is because Stephens only teaches or suggests two plies (12' and 12") from the same material (i.e., the "plastic envelope 12"), rendering it impossible for Stephens to teach both a "fragile layer" and a "durable layer" from the transparent thermoplastic material of the "plastic envelope 12."

With respect to Applicants' argument that there is no suggestion or motivation to combine the documents, the Examiner responded by asserting that "[i]n this case, all of the cited references are clearly in the field of endeavor of applicant's claimed invention." This assertion, however, does not address what explicit or implicit problem Stephens motivates one skilled in the art to solve, nor does it address what motivation is taught or suggested for one skilled in the art to print additional information on either of the plies 12' or 12" of Stephens (as discussed in Applicants' May 24, 2005 response).

The Examiner also asserts that "[i]n response to applicant's argument that the combination of Stephens and Smith is untenable, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combination teaches of the references would have suggested to those of ordinary skill in the art. See *In re keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

The remainder of this portion of the MPEP cited by the Examiner goes on to state that "[h]owever, the claimed combination cannot change the principle of operation of the primary reference or render the reference inoperable for its intended purpose. See MPEP § 2143.01." (M.P.E.P. 2145, sec. III). As provided in Applicants' May 24, 2005 response, the modification proposed by the Examiner would change the principle of operation of and render the "personal information packet 10" of Stephens unsatisfactory for its intended purpose.

Finally, the Examiner asserted that Applicants presented argument that the Examiner's conclusion of obviousness was based upon improper hindsight reasoning. Applicant is unclear as to why the Examiner has made this assertion. Applicants' respectfully submit that arguments based on hindsight reasoning have not been used by the Applicants, nor are they necessary, as the cited documents do not rise to the level of supporting a proper prima facie case of obviousness against the pending claims.

Based on the forgoing, Applicants respectfully submit that each and every element as recited in independent claims 1 and 2 is not taught or suggested in cited documents, and that there is insufficient motivation to combine the cited documents. Therefore, the § 103 rejection should be withdrawn.

Claims 23 and 24

The Examiner has essentially repeated the rejection of claims 23 and 24 as presented in the Office Action dated February 24, 2005. In response, Applicants respectfully repeat their May 24, 2005 discussion as to why Stephens does not support a proper conclusion of inherently teaching the methods of claims 23 and 24, and why Stephens and Smith do not support a proper prima facie case of obviousness.

Based on the forgoing, Applicants respectfully submit that each and every element as recited in independent claims 23 and 24 are not taught or suggested in the cited documents, and that there is insufficient motivation to combine the cited documents. Therefore, the § 103 rejection should be withdrawn.

Reconsideration and withdrawal of the § 103 rejection for the above independent claims, as well as those claims which depend therefrom, are respectfully requested.

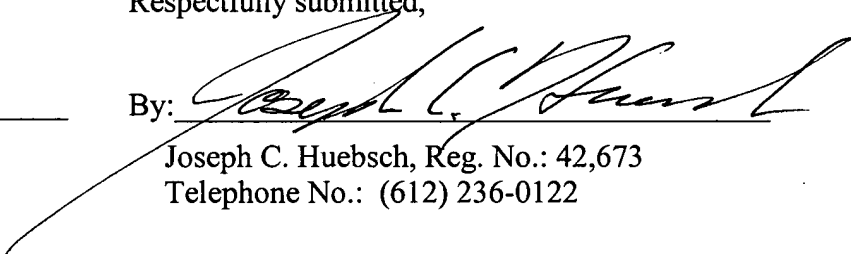
In view of the above, it is submitted that the application is in condition for allowance.
Reconsideration and allowance of the pending claims is respectfully requested.

The Examiner is invited to telephone the applicants' below signed attorney or Melissa E. Buss, Esq. at (651) 733-0649 to facilitate prosecution of this application.

Respectfully submitted,

10/21/05
Date

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